

REMARKS

The Examiner is thanked for the allowance of the subject matter of claims 12 and 13.

Claim 13 has been amended to further particularly point out and distinctly claim subject matter regarded as the invention.

Claim 12 has been cancelled, without prejudice.

New claim 16 also particularly points out and distinctly claims subject matter regarded as the invention. Specifically, claim 16 includes the subject matter of allowable claim 12 and the intervening independent claim 8.

The amendments here presented are made for the purposes of better defining the invention, rather than to overcome the rejections for patentability. Support for the amendments herein presented can be found in the specification and claims as filed. No new matter has been introduced as a result of the amendments. Reconsideration and allowance is respectfully requested in view of the amendments and the following remarks.

Election With Traverse

A restriction requirement has been imposed by the Examiner and a provisional election was made with traverse to prosecute the invention of claims 8-15 in a telephone conversation with the Examiner on or about September 9, 2002. That provisional election is hereby confirmed.

The 35 U.S.C. § 112 Rejection

Claim 13 stands rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter applicant regards as the invention. This objection is respectfully traversed.

Claim 13 has been amended to depend from new claim 16 and now has proper antecedent basis. With this amendment it is respectfully submitted the claims satisfy the statutory requirements.

Judicially-created Double Patenting

Claims 8-15 have been rejected pursuant to the judicially-created doctrine of obviousness-type double patenting as being unpatentable over claims 1-17 of prior United States Patent No. 6,354,301. Submitted herewith is a Terminal Disclaimer executed by the owner of all right, title, and interest in both the above-identified patent application and in United States Patent No. 6,354,301. Withdrawal of this rejection is respectfully requested.

The 35 U.S.C. § 103 Rejection

Claims 8-11 and 14-15 stand rejected under 35 U.S.C. § 103 as being allegedly unpatentable over Kretzner (U.S. Patent No. 1,957,143) in view of Unger (U.S. Patent No. 3,863,647) and Carabias (U.S. Patent No. 933,360). This rejection is respectfully traversed.

In the Office Action at paper number 3, paragraph 10, the Office Action asserts that Kretzner discloses all that is recited in the claims. Asserting that character “a” corresponds to the claimed “lower chamber member”; character “c” corresponds to the claimed “bowl portion”; character “z” corresponds to the claimed “vapor intake orifice”;

characters “e” “f” and a tubular part of “a” corresponds to the claimed “vapor intake conduit”; character “d” corresponds to the claimed “smoking pipe conduit”; and character “b” corresponds to the claimed “upper chamber member.” The Office Action admits that the Kretzner reference does not disclose the claimed element of “a lower screen member disposed in the bowl portion of the lower chamber.” The Office Action admits that the Kretzner reference does not disclose the claimed element of “a generally-conical-shaped heat intake conduit.” The Office Action further asserts that Unger discloses a smoking pipe having a metal screen disposed in the bowl portion of its pipe, and in another embodiment discloses the use of two screens, and a second screen disclosed above the first screen in a pipe bowl. The Office Action asserts that the Unger teaching satisfies the limitation of claim 11 referencing Figures 1 and 1A. The Office Action asserts that it would have been obvious to modify the bowl of Kretzner to include metal screens since it is known, as evidenced by the Unger reference, to support smokable material in this manner, and so that, if desired, the upper portion having screen in the larger portion of the bowl can be used for smoking large leafy substances, while the smaller lower bowl which contains the smaller screen can be used to smoke finely particulated substances as taught in Unger. The Office Action further admits that Kretzner modified by Unger does not disclose the claimed element of “an upper chamber member including a generally-conical-shaped heat intake conduit.” The Office Action asserts that Carabias discloses an inhaler in the form of a smoking pipe which has a bowl B, the outlet of which is shaped in a generally conical manner referencing figure 3. The Office Action asserts that it would have been obvious to modify the outlet portion of the upper chamber member of Kretzner (which would obviously be adapted to accept an output from a heat source since such a source could be a match or heat gun such that it resembled the cone shape outlet of the pipe in Carabias. The Office Action asserts that it would have been obvious to

modify Kretzner since a pipe having a bowl outlet of said shape is known in the tobacco art as evidence by the disclosure of Carabias. The Office Action admits that there is no articulation in the combined references that the lower and upper chambers are mated in a substantially airtight manner. The Office Action asserts that despite the lack of teaching, it follows because the chambers are joined in such a manner wherein they are mated by external/internal threads on the surfaces of the respective members, such threading being conventional means in which to secure/connect two pieces in an airtight manner. The Office Action admits that the combined references do not have the exact threaded structure as claimed in claim [15], the limitation is not deemed to patentably distinguish the claim from the reference. The Office Action asserts that as the surfaces utilized to mate the two members together are obvious modifications since it is well known to utilize these means for securing items together- whether the threading is located on the exterior of the interior of the respective pieces. Applicant respectfully disagrees with the assertions of the Office Action.

The Kretzner reference teaches a tobacco pipe with a porous insert piece *c* that is recessed in step form. The Kretzner reference teaches that the porous bottom insert piece *c* acts as a filter. The bottom insert piece *c* includes a central hole *z* which opens into a recess *e* from which radial channels *f* lead to an annular channel *h*. The annular channel *h* is formed between the bore of the shell *a*, and the outer wall of the insert pieces *b* and *c*. The Kretzner reference is silent with respect to a lower screen member disposed in the bowl portion of the lower chamber portion over the vapor intake orifice. The Kretzner reference is silent with respect to a vaporization chamber including a generally-conical-shaped heat intake conduit communicating therewith and having a heat intake orifice at a distal end thereof and adapted to accept output from a heat source (See Kretzner at lines 8-60 and FIGS. 1, 2, and 3)

The Unger reference teaches a pipe comprising a block 12 with a passage 16 and bowl 18. The Unger reference teaches a metallic screen 20 seated on an annular shoulder portion 22 formed in the bowl 18. The Unger reference teaches an additional bowl 18B including an additional metallic screen 20B. (See Unger at column 2, lines 29-49, column 4, lines 35-50 and FIGS. 1, 1A and 4) The Unger reference teaches a smoking pipe with easy draw of large volumes of smoke from burning material made possible through a structural arrangement of a pipe which affords laminar flow throughout a flow passage running from the bowl 18 to the pipe stem 24 interior to a lip end 28 of the pipe stem 24. (See Unger at Abstract). The Unger reference teaches a pipe design that is dimensioned and configured to assure maintenance of laminar flow of smoke from the charge on the screen to the smoker. The Unger reference teaches that pipes having porous internal structures tend to accumulate tars within the porous structures. The Unger reference teaches that it is an object to provide a long lived easily cleanable pipe. (See Unger at column 1 lines 15-16, 30-31, and 54-58).

The Carabias reference teaches an inhaler attachment adapted to be fitted to a pipe or holder to receive a charge of medicament through which smoke is drawn. The Carabias reference teaches that the smoke passing through the sinuous passages absorb the medicament in the pockets of the passages and is inhaled. The Carabias reference teaches a bowl of a pipe or a cigar/cigarette holder B attaches to the chamber A. The Carabias reference teaches a mouth-piece C attached on the opposite end of the chamber A. The Carabias reference teaches that the bowl/holder B can accommodate a cigar or cigarette. (See Carabias at lines 5-110 and FIGS 1, 2, and 3). The Carabias reference is silent with regard to being adapted to accept output from a heat source. The Carabias

reference is silent with regard to being adapted to accept an output nozzle of a heat gun. The Carabias reference is silent with regard to modifying the element B in any manner.

For an obviousness rejection to be proper, the Examiner must meet the burden of establishing that all elements of the invention are disclosed in the prior art; that the prior art relied upon, coupled with knowledge generally available in the art at the time of the invention, must contain some suggestion or incentive that would have motivated the skilled artisan to modify a reference or combined references; and that the proposed modification of the prior art must have had a reasonable expectation of success, determined from the vantage point of the skilled artisan at the time the invention was made. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988); *In Re Wilson*, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970); *Amgen v. Chugai Pharmaceuticals Co.*, 927 U.S.P.Q.2d, 1016, 1023 (Fed. Cir. 1996).

Omission of an Element with Retention of the Element's Function Is an Indicia of Unobviousness. Note that the omission of an element and retention of its function is an indicia of unobviousness. *In re Edge*, 149 USPQ 556 (CCPA 1966).

The Kretzner reference teaches a porous bottom insert piece *c* with a recess *e* and radial channels *f* as well as a shell *a* with what the Office Action refers to as a tubular part. (See Kretzner at FIGS. 1, 2 and 3). The Office Action relies on these three elements to render the claimed element of a vapor intake conduit. The claimed invention eliminates the elements of radial channels *f* and the tubular part of shell *a* while retaining the function of directing vapor to the smoking piece. As dictated by the patent case law, elimination of the elements *f* and part of *a* is indicia of unobviousness. Applicant asserts that the combination of prior art references fail to make out a *prima facie* case of

obviousness. The Examiner is requested to provide evidence in support of the assertions of obviousness from the prior art cited or by Affidavit.

Additionally, even assuming that all elements of an invention are disclosed in the prior art, an Examiner cannot establish obviousness by locating references that describe various aspects of a patent applicant's invention without also providing evidence of the motivating force which would have impelled one skilled in the art to do what the patent applicant has done. *Ex parte Levengood*, 28 USPQ 1300 (Bd. Pat. App. Int. 1993). The references when viewed by themselves and not in retrospect, must suggest the invention. *In re Skoll*, 187 USPQ 481 (C.C.P.A. 1975).

FACT THAT REFERENCES CAN BE COMBINED OR MODIFIED IS NOT
SUFFICIENT TO ESTABLISH *PRIMA FACIE* OBVIOUSNESS

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 16 USPQ2d 1430 (Fed. Cir 1990).

Although a prior art device “may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so.” *In re Fritch*, 23 USPQ2d 1780 (Fed. Cir. 1992).

FACT THAT THE CLAIMED INVENTION IS WITHIN THE CAPABILITIES OF
ONE OF ORDINARY SKILL IN THE ART IS NOT SUFFICIENT BY ITSELF TO
ESTABLISH *PRIMA FACIE* OBVIOUSNESS

A statement that modification of the prior art to meet the claimed invention would have been well within the ordinary skill in the art at the time the claimed invention was made because the references relied upon teach all the aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references. *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993). The level of skill in the art cannot be relied upon to provide the suggestion to combine references. *Al-Site Corp. v VSI Int'l Inc.*, 50 USPQ2d 1161 (Fed. Cir. 1999).

The Office Action relies on what is known in the art as the motivation to combine the references of Kretzner, Unger and Carabias. The Office Action asserts that it would have been obvious to modify the bowl of Kretzner to include metal screens since it is known, as evidenced by the Unger reference to support smokable material in this manner, and so that, if desired, the upper portion having screen in the larger portion of the bowl can be used for smoking large leafy substances, while the smaller lower bowl which contains the smaller screen can be used to smoke finely particulated substances as taught in Unger. There is no suggestion or motivation in the prior art references of Kretzner and Unger to combine the smoking pipe of Kretzner with the smoking pipe of Unger. The Kretzner reference makes no mention or suggestion to add metal screens to the smoking pipe taught in Kretzner. Unger makes no suggestion or teaching to have any of the features of the Kretzner reference device such as a porous bottom insert piece recessed in the upper portion with an annular passage. The Kretzner reference makes no teaching or suggestion of smoking large leafy substances and finely particulated substances.

With regard to the combination of the Kretzner/Unger reference and the Carabias reference in order to find a generally-conical-shaped heat intake conduit, there is no evidence in the prior art combination of references to combine the references. The Office

Action relies on what is known in the art as motivation to combine. The Office Action asserts that it would have been obvious to modify Kretzner since a pipe having a bowl outlet of said shape is known in the tobacco art as evidenced by the disclosure of Carabias. The Kretzner reference has no teaching or suggestion to modify the top insert piece *b*. The Carabias reference has no teaching or suggestion to modify a smoking pipe to accept an output nozzle of a heat gun. The case law controlling patent prosecution dictates that merely finding individual elements in the prior art and piecing them together in order to meet all of the claimed elements is not sufficient to prove a *prima facie* case of obviousness. The Office Action also relies on what is well known in the art to render the claimed elements of said upper chamber member being adapted to mate with said lower chamber member by threads disposed on mating surfaces. It is improper to rely on what is well known in the art. Therefore the rejection for claims 14 and 15 are improper.

Finally, a factor cutting against a finding of motivation to combine or modify the prior art is when the prior art teaches away from the claimed combination. A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that the applicant took. See *In re Gurley*, 31 USPQ 2d 1130 (Fed. Cir. 1994).

The Unger reference teaches away from the Kretzner reference. The Unger reference teaches a pipe having a structural arrangement which affords laminar flow throughout a flow passage running from bowl to pipe stem interior to a lip end of the pipe stem. (See Unger at Abstract, column 4, lines 20-24, and FIG 4). The Unger reference teaches that pipes that tend to accumulate tars within porous internal structures are undesirable. The Unger reference teaches a pipe that eliminates the structures that accumulate tars. (See Unger at column 1, lines 10-31).

In contrast, the Kretzner reference teaches a tobacco pipe with a porous insert piece *c* that is recessed in step form. The Kretzner reference teaches that the porous bottom insert piece *c* acts as a filter. The bottom insert piece *c* includes a central hole *z* which opens into a recess *e* from which radial channels *f* lead to an annular channel *h*. The annular channel *h* is formed between the bore of the shell *a*, and the outer wall of the insert pieces *b* and *c*. The multiple channels and holes in no way promote laminar flow and it is asserted that the tortuous fluid flow path created by the Kretzner device ensures turbulent flow through the smoking pipe. One of ordinary skill in the art when reading the Kretzner reference clearly understands that laminar flow from bowl to lip piece is not attainable, thus would be discouraged from the Unger reference. The Kretzner reference teaches a porous insert that acts as a filter. The insert piece of Kretzner would accumulate tars and would not be easily cleanable. Again the Kretzner device teaches elements that are completely the opposite of the Unger reference. One of ordinary skill in the art upon reading the Kretzner reference would be dissuaded from the teachings of the Unger reference. Since the Kretzner reference teaches opposite of the Unger reference, the Kretzner reference teaches away from the Unger reference. Therefore, there is no motivation to combine the Kretzner reference with the Unger reference. Since there is no motivation to combine the references, there is no *prima facie* case of obviousness.

In view of the foregoing, it is respectfully requested that the rejection be withdrawn and it is respectfully asserted that the claims are now in condition for allowance.

The following paragraphs provide the “As Amended” changes in a Marked-up format.

IN THE CLAIMS

Marked-up

13. The two-piece smoking pipe vaporization chamber of claim [8] 16 wherein said at least one heated intake air turbulence member comprises an impeller disposed between said heat intake orifice and said vapor intake orifice.